

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Final Official Action, the Examiner rejected claims 1-4, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,690,175 to Ouchi et al., (hereinafter "Ouchi") in view of U.S. Patent No. 5,916,147 to Boury (hereinafter "Boury"). Additionally, the Examiner rejected claims 5-16 under 35 U.S.C. § 103(a) as being unpatentable over Ouchi and Boury and further in view of U.S. Patent No. 5,084,022 to Claude (hereinafter "Claude").

In response, Applicant respectfully traversed the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth in the Response of May 1, 2008 and reproduced below. However, independent claims 1 and 17 were amended to clarify their distinguishing features. In the Advisory Action issued on May 13, 2008, such amendment was not entered by the Examiner and is therefore set forth again herein.

In the response of November 19, 2007, the Applicant amended claims 1 and 17 to distinguish the endoscope recited therein from the combination of Gregory and Boury by reciting, "a thickness of a sheathing resin is varied in order to form the small-diameter portion, the large-diameter portion, and the tapered portion." The Examiner responded in the Final Official Action by replacing the Gregory reference with the Ouchi reference. In this regard, the Examiner argued that Gregory discloses a first section (3c) that is included in the soft portion and whose diameter is substantially the same, a large portion (3f) formed on the operator side of section 3c and has a larger diameter than the diameter of section 3c and a tapered portion (3d-e) linking portions 3c and 3f. The Examiner further argued that the

thickness of the sheathing resin (in sections 3c, 3d, 3e and 3f) varies in order to form the small, large and tapered portions.

Although not expressly recited in claims 1 and 17, Applicants respectfully submitted that it is inherent from the phrase “a thickness of a sheathing resin is varied” to mean that a thickness of a single integral sheathing resin is varied. However, in the interests of advancing prosecution, independent claims 1 and 17 were amended in response to the Final Official Action to expressly recite such features. Specifically, independent claim 1 was amended to recite:

“a small-diameter portion which is included in the soft portion and whose outer diameter is substantially the same over the whole length thereof;

a large-diameter portion which is formed on the operator side of the soft portion opposite to the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion;

a tapered portion linking the small-diameter portion and the large-diameter portion, wherein at least part of the tapered portion is disposed forward an endoscope portion separated 70 cm from the distal endoscope end; and

sheathing resin that is an integral member having a thickness which is varied in order to form the small-diameter portion, the large-diameter portion, and the tapered portion.”

Similarly, independent claim 17 was amended as follows:

”a soft portion including a small-diameter portion and a large-diameter portion;

the large diameter portion which is formed on the operator side of the soft portion opposite to the small diameter portion and whose outer diameter is larger than the outer diameter of the small diameter portion;

a tapered portion included in the soft portion linking the small-diameter portion and the large-diameter portion, wherein at least part of the tapered portion is separated 70 cm or less from a distal end; and

a sheathing resin that is an integral member having a thickness which is varied in order to form the small-diameter portion, the large-diameter portion and the tapered portion.”

Although such amendment was not entered by the Examiner, it is set forth again herein. The amendment to claims 1 and 17 is fully supported in the original disclosure, such as at Figure 3 and the accompanying description of the specification. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 1 and 17.

Independent claim 1 has been further amended to correct a minor error therein. Specifically, claim 1 has been amended to change “an insertion unit having a soft portion, the insertion portion having ...” to --an insertion unit having a soft portion, the insertion unit having...--.

Turning now to the prior art, in contrast to the endoscope and insertion unit therefore, recited in independent claims 1 and 17 respectively, Ouchi discloses several sheathing portions that are glued together to make up the sheathing. Furthermore, the advantages discussed in the previous response resulting from such features (the large, small and tapered portions can be smoothly linked) is not present in the multi-piece sheathing of Ouchi. Thus, the sheathing resin of Ouchi is not formed integrally but divided section by section as clearly seen in Figure 5 of Ouchi.

In the Advisory Action, the Examiner appears to assert that in the structure of Ouchi, the outer surface is connected seamlessly, which is substantially not different from “integral”. In contrast to the structure of Ouchi, Applicants submit that the structure of the endoscope and insertion unit for an endoscope, as recited in claims 1 and 17, respectively, that the small-diameter portion to the large-diameter portion via the tapered portion are formed with a sheathing resin that is an integral member having a thickness which is varied in order to form the small-diameter portion, the large-diameter portion, and the tapered portion. As

such, Applicants respectfully submit that the same is substantially different from the several sheathing portions that are glued together to make up the sheathing of Ouchi.

With regard to the rejection of claims 1-4, 17 and 18 under 35 U.S.C. § 103(a), independent claims 1 and 17 are not rendered obvious by the cited references because neither the Ouchi patent nor the Boury patent, whether taken alone or in combination, teach or suggest an endoscope and insertion unit therefore having the features discussed above and recited in independent claims 1 and 17, respectively. Accordingly, claims 1 and 17 patentably distinguish over the prior art and are allowable. Claims 2-4 and 18, being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-4, 17 and 18 under 35 U.S.C. § 103(a).

With regard to the rejection of claims 5-16 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 5-16 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 5-16 under 35 U.S.C. § 103(a).

Furthermore, new claim 19 has been added to further define the patentable invention. New claim 19 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 19.

With regard to claim 19, the configuration of the insertion portion comprises the small-diameter portion and the large-diameter portion each having a substantially constant outer diameter over their respective length and are connected integrally such as to include the tapered portion, thereby to maintain an inserting nature of the insertion portion. In contrast, as shown in 3c – 3f of Ouchi does not disclose such substantially constant outer diameters

(small-diameter portion, large-diameter portion). Thus, the structure of Ouchi is clearly substantially different from that of the endoscope of claim 19.

Applicants respectfully submit that new claim 19 is at least allowable as depending upon an allowable base claim (1) and claim 19 patentably distinguishes over Ouchi independently of its base claim for the reasons set forth above.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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